

The opinion in support of the decision being entered today was not written for publication and is not precedent of the Board.

Paper No. 46

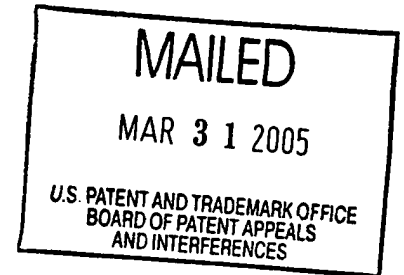
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUIS J. RODRIGUEZ

Appeal No. 2005-0041
Application No. 09/978,215

ON BRIEF



Before KIMLIN, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has submitted a Request for Rehearing (hereafter "Request") of our decision dated January 28, 2005.¹

We respond to each of appellant's numbered paragraphs in the same order as numbered in the Request, as indicated by each heading below.

¹The Request was made under 37 CFR § 1.197(b). Appellant is advised that the rule governing such a request is now located at 37 CFR § 41.52 (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

I. Paragraph 1

On page 1, in paragraph no. 1, of appellant's Request, appellant states that the Board has not considered the supplemental brief filed by appellant on July 28, 2004 (Paper No. 41). This is incorrect. This supplemental brief was filed in response to the examiner's supplemental examiner's answer mailed on July 20, 2004 (Paper No. 40). This document was in fact received and reviewed. For example, see footnote 2 on page 5 of our decision mailed January 28, 2005 (Paper No. 44). A copy of this supplemental brief is provided herewith as evidence of its receipt. We observe that in paragraph no. 1, on page 1 of the Request, appellant refers to a "supplemental brief", and a "supplemental reply brief", as the same document. The exact title of this document is actually "supplemental appeal brief", as made evident by appellant's submittal of this document with the Request, and as also made evident by our copy of this document, provided herewith. Hence, appellant refers to the "supplemental reply brief" as the same document as the "supplemental brief". This document is the supplemental appeal brief of Paper No. 41, filed on July 28, 2004.

Appellant also states that the reply brief, filed on September 8, 2003 (Paper No. 36) was not considered.¹ Appellant states that the reply brief and the supplemental appeal brief were

¹ This is incorrect, and a copy of the reply brief of Paper No. 36 is provided herewith, as evidence of its receipt and consideration. Also, footnote No. 2 on page 3 of our decision mailed on January 28, 2005 indicates review of this document.

not mentioned in the "Preliminary Matters" section of the decision, and therefore must not have been considered. We first note that just because a document may not have been mentioned in the "Preliminary Matters" section of the decision, it does not mean a document was not considered. The "Preliminary Matters" section of the decision is found on pages 2-5 of the decision. This section was not intended to provide a complete list of every filing that was considered, from the date of filing of appellant's application. Rather, this section was intended to provide a context for the determinations made in the Decision on Petition of June 2, 2003, because much of appellant's misunderstandings involve the examiner's proper handling of amendments, exhibits, attachments, and substitute specifications, as instructed by the Decision on Petition.

In summary, appellant is incorrect in asserting that the reply brief (Paper No. 36) and the supplemental appeal brief (Paper No. 41) were not considered. Both of these documents were in fact considered, as indicated by footnote 2 on page 5 of our decision.

In view of the above, appellant can be reassured that (1) the supplemental appeal brief filed on July 28, 2004 (Paper No. 41) (referred to by appellant in paragraph no. 1 as the supplemental brief or supplemental reply brief), and (2) the reply brief filed on September 8, 2003 (Paper No. 36), remain part of the record, and were carefully and fully reviewed by the Board in making the determinations set forth in the decision mailed on January 28, 2005. We reiterate that a copy of each of these documents is provided herewith.

II. Paragraph 2

Appellant repeats his assertion that the reply brief filed on September 8, 2003 (Paper No. 36), and the supplemental appeal brief, filed on July 28, 2004 (Paper No. 41) (again, it is noted that appellant refers to this document as the "supplemental reply brief"), have not been considered by asserting that these documents have "disappeared" before the Board could review them. This is incorrect, as made evident in the above discussion.

On page 2 of the Request, appellant states that after reading our decision mailed January 28, 2005, that he re-read the Decision on Petition of June 2, 2003, and now understands why certain amendments, attachments, and exhibits were not considered by the examiner, pursuant the instructions set forth in the Decision on Petition of June 2, 2003. We refer to pages 2-5 of our decision mailed January 28, 2005, regarding this issue, and reiterate it here.

Appellant also states that amendment C remains "in full force". This is not an entirely accurate understanding of Amendment C, and we refer pages 2-5 of our decision regarding which parts of Amendment C are deemed part of the record and entered. As clearly explained, pursuant to the instructions of the Decision on Petition of June 2, 2003, only parts of Amendment C are deemed part of the record as entered.

Appellant states that Exhibit A² is in the record. This document was discussed on page 7 of our decision mailed January 28, 2005. This document was referred to in our decision as the "Model of Exhibit A" or, as set forth in footnote 3, as "Model Inside (Exhibit A)". We indicated that this document was entered and considered by the examiner, and was also considered by the Board. See page 7, second full paragraph, and footnote no. 3, of our decision mailed January 28, 2005.³

On page 2 of the Request, appellant also discusses his document entitled "Summary of Interview of October 29, 2002". Appellant indicates that he has provided a copy of this document with the Request. This document was filed and received on November 22, 2002 (Paper No. 17). A copy of it is provided herewith as evidence of its receipt.

² This is to be distinguished from the document entitled "Exhibit A" that was filed with Amendment A on May 20, 2002, which was discussed on page 13 of Amendment A (Paper No. 6).

³ Correction is required regarding our summary of the examiner's Advisory Action (Paper No. 15), as discussed on page 3 of our decision mailed January 28, 2004. We correctly provided a summary of this examiner's Advisory Action in footnote 3, on page 7 of our decision. The summary in the second full paragraph found on page 3 of the decision should have contained the same summary provided in footnote 3. We note that in examiner's Advisory Action (Paper No. 15), the examiner marked box no. 6, indicating that the "affidavit or exhibit will NOT be considered", but that this did not apply to the Model of Exhibit A, because the examiner separately addressed the Model of Exhibit A by marking box no. 10, on page 1 of the Advisory Action, and by providing a continuation sheet on page 2 of the Advisory Action. A copy of this Advisory Action is provided herewith. Most importantly, we clearly explained in our footnote no. 3, on page 7 of the decision mailed on January 28, 2005, that the Model of Exhibit A was entered and considered by the examiner. Also, in paragraph 2 on page 7 of the decision, we indicated that we considered this document. Hence, there should be no doubt that the Board was fully aware that the examiner entered and considered this document, and that the Board considered this document also.

We also provide a copy of the Examiner's Interview Summary mailed November 1, 2002 (Paper No. 16), in connection with the interview conducted on October 29, 2002. As discussed in footnote 3, on page 7, of our decision of January 28, 2005, the examiner indicated, in this Interview Summary, that no exhibit was shown or no demonstration was conducted. See page 1 of this Examiner's Interview Summary.

III. Paragraph 3

At the top of page 3 of the Request, the appellant alleges that his interview summary submitted on November 22, 2002 proves that the examiner's interview summary was untruthful. Appellant states that the Model of Exhibit A has been entered, and this proves the untruthfulness of the examiner's interview summary.⁴ As discussed, supra, in the Advisory Action of Paper No. 15, the examiner indicated that the Model of Exhibit A has been considered and entered. The Board also considered this document as indicated on page 7 of the decision mailed January 28, 2005 (see the second full paragraph and footnote 3 on page 7 of the decision).

⁴Appellant refers to the first paragraph on page 4 of appellant's Summary of Interview and states that "the presentation of the entered model and its comparison with the cited art was discussed."

We believe appellant misunderstands the meaning of the checked box e on page 1 of the examiner's Interview Summary (Paper No. 16). The examiner checked this box because in fact no exhibit was shown to him during the telephonic interview with appellant. This marked box does not mean that the examiner did not enter and consider the model of Exhibit A. The examiner clearly indicated that this exhibit was entered and considered in the previous paper No. 15 (i.e., the Advisory Action).

IV. Paragraph 4

Appellant again states that there is silence about the reply brief and supplemental reply brief⁵. As already discussed, supra, this is incorrect.

Appellant sets forth items a. through g. on pages 3-4 of the Request, asserting that a new ground of rejection was raised by the examiner in the answer. We refer to page 5 of our decision mailed January 28, 2005, wherein it is stated that the examiner addressed this issue in the supplemental examiner's answer, and that we agree with the examiner's position on this issue that no new ground of rejection was raised.

We further note that any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely raised by way of petition under 37 CFR 1.181(a).

⁵ We again note that appellant's reference to "supplemental reply brief" is a referral to the supplement appeal brief that was filed July 28, 2004 (Paper No. 41).

V. Paragraph 5

Appellant again alleges that the Board ignored the reply brief and the supplemental reply brief (i.e., the supplemental appeal brief filed July 28, 2004 of Paper No. 41). This is incorrect. We refer to our discussions on this issue, as set forth, supra.

VI. Paragraph 6

Appellant alleges that the decision appears to confuse Exhibit A with Affidavit 4. We refer to our footnote 3 located on page 5, supra.

VII. Paragraph 7

Appellant alleges that the new examiner (Jes F. Pascua) who was the signatory for the examiner's answer and for the supplemental examiner's answer, and the old examiner (Steven P. Garbe) who was the signatory for the final rejection of Paper No. 12, presented different rejections. We note that in the examiner's answer, the examiner actually relies upon the prior Office Action of Paper No. 12, when presenting each of the rejections, which shows that Examiner Pascua presented the same rejections as presented by Examiner Garbe.

We again note that any allegation that an examiner's answer contains an impermissible new ground of rejection is waived if not timely raised by way of petition under 37 CFR 1.181(a).

VIII. Paragraph 8

Appellant alleges that there is confusion about the claimed invention by the Board because the Board refers to

Figure 7a and no other figure. This is an incorrect statement for the following reasons.

On page 7 of our decision mailed January 28, 2005, we stated "[w]e refer to the first embodiment, as an example. The first embodiment is described, beginning on page 12 of appellant's specification. It involves Figure 7a-Figure 7f." Clearly, we understand that there are several embodiments in the specification, and we referred to the first embodiment, as an example, for discussion. In making our determinations in our decision mailed January 28, 2005, we reviewed appellant's entire specification, including all the Figures, and have a full understanding of the claimed invention.

At paragraph 8 ii., on page 5 of the Request, appellant again asserts that Examiner Pascua raised a new ground of rejection. This is incorrect for the reasons discussed, supra. We add the following for the sake of appellant's understanding of this issue.

It appears the appellant does not understand that there is no new ground of rejection when the basic thrust of the rejection remains the same. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis remains the same, and the evidence relied upon in support of the rejection remains the same, such supports that the rejection is not a new ground of rejection. Id. at 1303, 190 USPQ at 427.

At paragraph 8 iii., appellant reiterates his assertion that the examiner raised a new ground of rejection by discussing the mono-sectional body of Schieman. We again disagree, for the reasons discussed, supra. We also reiterate, that while we have discussed this matter for the sake of appellant's understanding of this issue, this allegation by appellant that the answer contains an impermissible new ground of rejection has been waived by appellant, as it is a petitionable matter. 37 CFR 1.181(a).

With regard to paragraph 8 iv. and v., on pages 5-6 of the Request, appellant discusses the alleged lack of clarity of the term "mono-sectional", and refers to MPEP § 2173.05(e) and MPEP § 2173.02. We refer to our discussion of the 35 U.S.C. 112, first paragraph rejection of claims 45-49, made on pages 5-8, and pages 20-21, of the decision mailed on January 28, 2005, and for those reasons discussed therein, we are not convinced by appellant's discussion here.

With regard to paragraph 8 vi., presented at the bottom of page 6 of the Request, appellant discusses both the Schieman and Wilbur patents, and asks "[h]ow does that reconcile with the rejections?" We simply refer to our discussion of the rejections involving these references in our decision mailed January 28, 2005. In that decision, these references were clearly discussed and the rejections were clearly discussed. This query by appellant does not convince us of any error regarding these rejections.

With regard to paragraph 8 vii., at the top of page 7 of the Request, appellant asserts that our decision mailed January 28, 2005 overlooks the simple fact that a sheet of paper is a sheet of paper, and an envelope is a container. It appears to us that appellant does not appreciate our discussion made, for example, on pages 9-10 of our decision mailed January 28, 2005. In that discussion, we clearly explained how the claimed language of a "self-sealing letter sheet" does not exclude a sheet that is at some point an "envelope", such as the envelope shown in Schieman.

With respect to paragraph 8 viii., appellant again reiterates the idea that his invention cannot include an envelope. We again refer to our discussion made on pages 9-10 of our decision mailed on January 28, 2005.

With regard to paragraph 8 ix., appellant again alleges that the Board has overlooked the reply brief and the supplemental appeal brief. This is incorrect, for the reasons stated, supra. Appellant provides another reason for this assertion. Appellant asserts that the reply brief and supplemental appeal brief have been overlooked because the Board stated on page 12 of the decision of January 28, 2005 that appellant does not dispute the teachings of Johnson as discussed by the examiner. Appellant states that he has disputed all the arguments by both the original examiner and the new examiner.

Appellant misconstrues our statement made page 12 of the decision of January 28, 2005. We stated that "the examiner states that Johnson teaches the claimed invention except for the use of an adhesive inhibitor." We go on to the state "[a]ppellant does not dispute the teachings of Johnson as discussed by the examiner." The examiner discusses the teaching of Johnson on pages 5-6 of the final Office Action of Paper No. 12, mailed September 11, 2002. The examiner states that Johnson discloses a form having all the claimed features except for the claimed adhesive inhibitor. Appellant does not dispute these particular findings made by the examiner. Rather, appellant argues the combination of references of Johnson in view of Wilbur or Schieman.

Most importantly, appellant can be assured that both the reply brief and the supplemental appeal brief were been fully considered by us in making the determinations set forth in our decision mailed January 28, 2005.

With regard to paragraph 8 x., on page 8 of the Request, appellant explains that his discussion on pages 18-19 of his reply brief regarding the mode of production was to show that there is no motivation or expectation of success with regard to the combination of references applied by the examiner. We fully appreciated appellant's arguments made in his reply brief, in this regard, when making our determinations set forth in our decision mailed January 28, 2005.

IX. List of Attachments

1. Supplemental Appeal Brief filed July 28, 2004 (Paper No. 41)
2. Reply Brief filed on September 8, 2003 (Paper No. 36)
3. Advisory Action mailed on October 25, 2002 (Paper No. 15)
4. Examiner's Interview Summary mailed on November 1, 2002 (Paper No. 16)
5. Appellant's Summary of Interview filed on November 22, 2002 (Paper No. 17)

X. Conclusion

We do not find in the Request any argument convincing us of error in the conclusions we reached in our decision mailed January 28, 2005. Accordingly, appellant's Request for Rehearing is denied.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

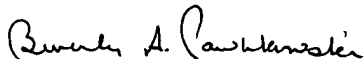
DENIED



EDWARD C. KIMLIN
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge



BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

BAP/sld

Appeal No. 2005-0041
Application No. 09/978,215

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